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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,747	05/31/2001	Bijan Tadayon	111325-68	5717

22204 7590 02/10/2004

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,747

Applicant(s)

TADAYON ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notes

1. As to claims 1-9 and 17-25, the steps of generating, associating, and securing are interpreted to be associated with the digital work as claimed in the preambles. Thus, the subject matters are claimed in claims 1-9 and 17-25 are within the technological arts, and are considered to be statutory subject matters.

2. As to claims 10-16, the "content creation device", and the "rights assignment engine" are interpreted as the devices with both hardware (i.e. processor) and software (computer executable code) features as describe in page 8 of specification.

Accordingly, the "content creation device", and the "rights assignment engine" are considered to be statutory subject matters.

Specification

3. The disclosure is objected to because of the following informalities:

in line 10 of page 8, the phrase "Fig. 3" should be "Fig. 2".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-12, 14 and 17-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al., U. S. Patent 6,574,609.

As to claims 1 and 17, Downs teaches a method for creating a digital work having content and usage rights related to the content, the method comprising (abstract):

- a) Generating a label having usage rights associated with content of a digital work before the content is created (column 9 lines 45-60 and column 17 lines 19-48 and Fig. 1A; *specifically, "a label" corresponds to the usage conditions in column 17 lines 19-33, and the content corresponds to the compressed content in column 17 lines 37-43*);
- b) Storing the label in a content creation device (column 17 lines 29-32; *specifically, "a content creation device" corresponds to the Content Provider 101 in Fig. 1A*);
- c) Creating the content with the content creation device (column 17 lines 37-44);
- d) Associating the label with the content after the content is created (column 9 lines 45-60 and column 17 lines 44-53 and Fig. 1A);
- e) Securing the content and the label (column 9 lines 45-60 and column 17 lines 44-53 and Fig. 1A).

As to claims 2 and 18, Downs teaches securing step comprises encrypting and storing the content and the label (column 17 lines 44-53 and Fig. 1A).

As to claims 3 and 19, Downs teaches granting access to the content in accordance with the usage rights (column 7 lines 28-31 and column 20 lines 17-29 and column 25 lines 1-7).

As to claims 4 and 20, Downs teaches said generating step comprises generating usage rights specifying a user's right to at least one of alter, edit, copy, or view the content (column 7 lines 28-31 and column 20 lines 17-29).

As to claims 5 and 21, Downs teaches creating audio based element as the content after said generating step and before said associating step (column 9 lines 62-67 and column 17 lines 19-53 and Fig. 1A; *specifically, "creating audio based element" corresponds to equalization, dynamic range adjustments and re-sampling" in Down's teaching*).

As to claims 6 and 22, Downs teaches said generating step further comprises: assigning a predetermined secure key to be associated with the content and wherein said securing step comprises encrypting the content and the label with the secure key (column 17 lines 44-53 and Fig. 1A; *specifically, the secure key corresponds to the Symmetric Key*).

As to claims 7 and 23, Downs teaches said creating step comprises recording content with a recording device and wherein said associating step and said securing step are accomplished by the recording device (column 17 lines 44-53 and Fig. 1A; *specifically, the recording device corresponds to Content SC*).

As to claims 8 and 24, creating the label in an external computing device and downloading the label into the recording device prior to said associating step are taught

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by Downs as creating the label in an Metadata Assimilation and Entry Tool (see *items 124 and 161 in Fig. 1A*) and the label is to be transmitted into the recording device before said associating step (column 9 lines 56-57 and column 17 lines 29-53 and Fig. 1A; *specifically, the label corresponds to the usage conditions the recording device corresponds to Content SC*).

As to claims 9 and 25, Downs teaches creating the label in the recording device prior to said associating step (column 17 lines 29-53).

As to claim 10, Downs teaches a system for creating a digital work having content and usage rights, the system comprising (abstract):

- a) A content creation device for creating a digital content (column 9 lines 63-67 and column 17 lines 37-44 and Fig. 1A; *specifically, "a content creation device" corresponds to the content preprocessor tool, and "a digital content" corresponds to an equalized, dynamic range adjusted, re-sampled, or compressed digital content in Downs' teaching*);
- b) A rights assignment engine associated with the content creative device, the rights assignment engine automatically attaching predetermined usage rights to the content and securing the content with the usage rights (column 9 lines 45-60 and column 17 lines 29-53 and Fig. 1A; *specifically, the rights assignment engine corresponds to the SC Packer Tool, and "predetermined usage rights" corresponds to the usage conditions in Downs' teaching*).

As to claim 11, Downs teaches an identification device for identifying user of the content creation device; and means for determining the usage rights based on the user

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(column 7 lines 37-40, 55-64 and column 18 lines 42-46 and Fig. 1C; specifically, "an identification device" corresponds to the Clearinghouse in Down's teaching).

As to claim 12, Downs teaches said content creation device comprises an audio recorder (column 62 lines 26-41).

As to claim 14, Downs teaches a secure storage medium for the storage of fee and payment information associated with the usage rights (column 10 lines 34-42 and column 75 lines 5-18).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al., U. S. Patent 6,574,609 in view of Byford, U. S. Patent 6,581,161.

As to claim 13, Downs teaches an identification device for identifying user of the content creation device as discussed in claim 11 above. Downs does not specifically teach the identification device comprises a biometrics sensor. However, Byford teaches an identification device comprising a biometric sensor for controlling access of a secured facility (column 4 lines 44-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the identification device in Downs' teaching to include a biometric sensor for better protecting the digital contents from unauthorized access.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al., U. S. Patent 6,574,609 in view of Liaguno et al., U. S. Patent 5,729,741.

As to claims 15-16, Downs teaches a content creation device for creating a digital content as discussed in claims 10-11 above. Downs does not specifically teach said content creation device comprises a video recorder and a still picture camera. However, Liaguno teaches importing content from a video recorder and a still picture camera (column 7 lines 39-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made allow the content creation device in Downs' teaching to include a video recorder and a still picture camera because this would allow the content creation device to create the digital content by using variety types of devices (i.e. video recorder), and thus to attractive more people to use the variety types of devices to create the digital contents.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rhoads (U. S. Patent 6,311,214) discloses linking computers based on optical sensing of digital data.

Wiser et al. (U. S. Patent 6,385,596) discloses online music distribution system provides for the secure delivery of audio data and related media over a public communications network.

Herpel et al. (EP 1 045 388 A1) discloses preventing illegal usages of multimedia content.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
January 20, 2004

